

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

| | | |
|--|---|--------------------------------|
| Appellants: Tevis et al. |) | Examiner: Elena T. Lightfood |
| |) | |
| Serial Number: 10/528,220 |) | Group Art Unit: 1792 |
| |) | |
| Filed: March 18, 2005 |) | Customer Number: 22827 |
| |) | |
| Confirmation No.: 6257 |) | Deposit Account: 04-1403 |
| |) | |
| Title: "Methods for Applying Coating Compositions to an Article and Articles Produced Thereof" |) | Docket Number: SGI-0084-PCT-US |
| |) | |

1. ☐ **NOTICE OF APPEAL:** Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals and interferences from the last decision of the Examiner.
2. ☐ **PRE-APPEAL BRIEF REQUEST FOR REVIEW:** Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated on the attached sheet(s) [No more than five (5) pages may be provided.]
3. ☐ **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy).
4. ☐ An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within two months after Examiner's Answer).
5. ☒ Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
6. ☐ "Small entity" verified statement filed: [] herewith [] previously.

7. **FEE CALCULATION:**

| | Fees |
|--|----------------|
| If box 1 above is X'd enter \$ 540.00 | \$ <u>0.00</u> |
| If box 2 above is X'd enter \$ 0.00 (no fee) | \$ <u>0.00</u> |
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| If box 5 above is X-d enter \$ 0.00 (no fee) | \$ <u>0.00</u> |

PETITION is hereby made to extend the original due date of October 6, 2010, hereby made for an extension to cover the date this response is filed for which the requisite fee is enclosed (1 month \$130; 2 months \$490; 3 months \$1,110; 4 months \$1,730, 5 months \$2,350) \$ 0.00

SUBTOTAL: \$ 0.00

Less any previous extension fee paid since above original due date. - \$ 0.00

Less any previous fee paid for prior Notice of Appeal since Board did not render a decision on the merits. MPEP § 1204.01 - \$ 0.00

Less any previous fee paid for submitting Brief on prior Appeal since
Board did not render a decision on the merits. MPEP § 1204.01 - \$ 0.00

SUBTOTAL: \$ 0.00

If "small entity" verified statement filed ☐ previously,
☐ herewith, enter one-half (1/2) of subtotal and subtract - \$ 0.00

TOTAL FEE ENCLOSED: \$ 0.00

- ☐ Fee enclosed.
- ☐ Charge fee to our Deposit Account/Order Nos. in the heading hereof (for which purpose one additional copy of this sheet is attached)
- ☐ Charge to credit card (attach Credit Card Payment Form – PTO 2038)
- ☐ Fee NOT required since paid in prior appeal in which the Board of Appeals did not render a decision on the merits.

The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any fees in addition to the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (deficiency only) now or hereafter relative to this application and the resulting official document under Rule 20, or credit any overpayment, to our Account No. shown in the heading hereof. This statement does not authorize charge of the issue fee in this case.

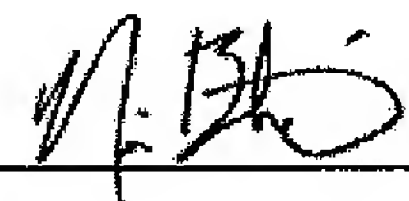
DORITY & MANNING ATTORNEYS AT LAW, P.A.

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Date: October 6, 2010

I hereby certify that this correspondence and all attachments and any fee(s) are being electronically transmitted via the internet to the U.S. Patent and Trademark Office using the Electronic Patent Filing System on October 6, 2010.

Heidi M. Lewis

(Typed or printed name of person transmitting documents)



(Signature of person transmitting documents)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

| | | | | |
|-------------------|---|---|------------------|--------------------|
| Application of: | Tevis et al. |) | Examiner: | Elena T. Lightfoot |
| | |) | | |
| Serial Number: | 10/528,220 |) | Group Art Unit: | 1792 |
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| | |) | | |

REPLY BRIEF TO EXAMINER'S ANSWER

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits the following Reply Brief in accordance with 37 C.F.R. §41.41
in response to the Examiner's Answer dated August 6, 2010.

1. REAL PARTY IN INTEREST

See Appellants' Brief on Appeal.

2. RELATED APPEALS AND INTERFERENCES

See Appellants' Brief on Appeal.

3. STATUS OF CLAIMS

See Appellants' Brief on Appeal.

4. STATUS OF AMENDMENTS

See Appellants' Brief on Appeal.

5. SUMMARY OF CLAIMED SUBJECT MATTER

See Appellants' Brief on Appeal.

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

See Appellants' Brief on Appeal.

7. ARGUMENT

Please see Appellants' Brief on Appeal, in which all of the previously presented arguments are incorporated by reference herein.

In the Examiner's Answer dated August 6, 2010, the Examiner acknowledges that U.S. Patent No. 6,899,752 to Sekioka et al. "is not available as prior art under 35 U.S.C. §102 (b) or (e)." Page 3, August 6, 2010 Answer. To remedy this deficiency, the Examiner states that "WO 0240607A1 and AU 200214317A (of the same patent family as US 6,899,752) were published in May 2002, and thus, are available as prior art under 35 U.S.C. 102 (a)." *Id.*

However, a search of the European Patent Office website indicates that WO 0240607A1 published in May 2002 in Japanese and AU 200214317A also published in May 2002 in Japanese. The Examiner appears to be assuming that U.S. Patent No. 6,899,752 includes the same disclosure as that found in applications for the corresponding Japanese language publications. As stated in Appellant's Appeal Brief, the Examiner has never provided any information regarding the content of any

Japanese language publications. As such Appellants are not in a position to ascertain whether such references are proper 102 (a) references and the Examiner has not provided any information in support of the position that such references are proper. Indeed, although the Examiner maintains that the AU 200214317A reference is not cited in the Examiner's Answer "for convenience", it is respectfully submitted that the Examiner would be required to provide a translation of such reference with citation to appropriate sections in order to meet her burden under the rules.

If the AU 200214317A reference is allowed to stand as a proper 102(a) reference, Appellants reiterate the other arguments presented in the Appeal Brief and incorporated by reference herein as to why the presently pending claims patentably define over U.S. Patent No. 6,899,752 to Sekioka et al.

For the reasons stated above, it is Appellants' position that the Examiner's rejection of claims has been shown to be untenable and should be **reversed** by the Board. Please charge any additional fees required by this Appeal Brief to Deposit Account No. 04-1403.

Respectfully submitted,

DORITY & MANNING, P.A.

A handwritten signature in dark ink, appearing to read "N. Batavia", is written over a horizontal line.

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October 6, 2010
Date

9. CLAIMS APPENDIX

1-23. (Canceled).

24. (Withdrawn) An article having an outer surface and at least three layers of coating, comprising: a first layer created from the application of a first composition of a first oligomer of an energy-curable oligomer, the first composition being dried upon the outer surface of the article to produce the first layer, and the first layer having an outer surface; a second layer created from the application of a second composition of a second oligomer of an energy-curable oligomer, the second composition being dried upon the outer surface of the first layer to produce the second layer, and the second layer having an outer surface; and a third layer created from the application of a third composition of a third oligomer of an energy-curable oligomer, the third composition applied to the outer surface of the second layer to produce a third layer, and the applied third layer being cured such that the first oligomer, the second oligomer, and the third oligomer are cured.

25. (Rejected) A method for applying an image onto a game card, the method comprising the steps of:

(a) applying a first composition comprising a first oligomer comprising an energy-curable oligomer to the outer surface of the game card to produce a first layer, wherein after the application step (a), a first layer comprising the first oligomer is on the outer surface of the game card, and wherein the first layer has an outer surface;

(b) drying the game card produced after step (a);

(c) at least partially curing the first composition;

(d) applying a second composition comprising a second oligomer comprising an energy-curable oligomer to the outer surface of the first layer to produce a second layer, wherein after the application step (d), the second layer is on the outer surface of the first layer, and wherein the second layer has an outer surface;

(e) drying the game card produced after step (d);

(f) at least partially curing the second composition;

(g) applying a third composition comprising a third oligomer comprising an energy-curable oligomer to the outer surface of the second layer to produce a third layer, wherein after the application step (g), the third layer is on the outer surface of the second layer;

(h) curing the first oligomer, the second oligomer, and the third oligomer; and

(i) applying an ink to the outer surface of the first layer, or the outer surface of the second layer, or to both, so as to form an image.

26. (Rejected) The method of claim 25, wherein the composition in steps (a), (d) and (g) is applied by flexography, roto gravure, screen printing, offset, letter press or roll coater.

27. (Rejected) The method of claim 25, wherein the first oligomer and second oligomer are water based.

28. (Rejected) The method of claim 25, wherein the first oligomer, the second oligomer and the third oligomer comprises an epoxy acrylate, a urethane acrylate, a polyester acrylate, an acrylated acrylic, a cycloaliphatic diepoxide or a combination thereof.

29. (Rejected) The method of claim 25, wherein the first oligomer, the second oligomer and the third oligomer comprises (1) a polyester or urethane having an acrylate group or (2) a cycloaliphatic diepoxide.

30. (Rejected) The method of claim 25, wherein the first oligomer and second oligomer is from 10% to 40% by weight of the first composition and second composition.

31. (Rejected) The method of claim 25, wherein the third oligomer is from 15% to 50% by weight of the third composition.

32. (Rejected) The method of claim 25, wherein the third oligomer is not water-based.

33. (Rejected) The method of claim 25, wherein the first composition comprises water, a surfactant, a thickener, a pigment or dye, and a first oligomer comprising a water-based, energy-curable oligomer.
34. (Rejected) The method of claim 25, wherein the second composition comprises water, a surfactant, a thickener, an absorbent, a pigment or dye, and a second oligomer comprising a water-based, energy-curable oligomer.
35. (Rejected) The method of claim 25, wherein the third composition comprises a surfactant, a slip additive, a release additive, a wax and a third oligomer comprising an energy-curable oligomer.
36. (Rejected) The method of claim 25, wherein the drying steps (b) and (e) are performed by a dryer at a temperature of from 230°F to 390°F in the presence of a large flow of air volume.
37. (Rejected) The method of claim 25, wherein the curing step (f) is performed by exposing the game card produced after step (g) to an electron beam or UV lamp.
38. (Cancelled).
39. (Rejected) The method of claim 25, wherein the ink is water-based.
40. (Rejected) A method for applying a coating composition to a lottery ticket having an outer surface, comprising
- (a) applying a first composition comprising a first oligomer comprising an energy-curable, water-based oligomer to the outer surface of the ticket to produce a first layer, wherein after the application step (a), a first layer comprising the first oligomer is on the outer surface of the ticket, and wherein the first layer has an outer surface;
 - (b) drying the ticket produced after step (a) at a temperature of from 230 ° F to 390 ° F in the presence of a large flow of air volume while also partially curing the first oligomer;
 - (c) applying a second composition comprising a second oligomer comprising an energy-curable, water-based oligomer to the outer surface of the first layer to produce a

second layer, wherein after the application step (c), the second layer is on the outer surface of the first layer, and wherein the second layer has an outer surface;

(d) drying the ticket produced after step (c) at a temperature of from 230° F to 390° F in the presence of a large flow of air volume while also partially curing the second oligomer;

(e) applying an image ink to the outer surface of the second layer to produce an image;

(f) drying the ticket produced after step (e);

(g) applying a third composition comprising a third oligomer comprising energy-curable oligomer over the image and the outer surface of the second layer to produce a third layer; and

(h) curing the first oligomer, the second oligomer, and the third oligomer with an electron beam, wherein the first oligomer, the second oligomer and/or the third oligomer comprises a polyester acrylate, urethane acrylate, an epoxy acrylate or a combination thereof.

10. EVIDENCE APPENDIX

None

11. RELATED PROCEEDINGS APPENDIX

None